

## REMARKS

Claims 17-24, 27-28 and 30-39 are pending in the present application. By this Amendment, the specification is amended, previously presented claims 17, 21, 27-28, 30 and 33-35 are amended; previously presented claims 25-26 and 29 are cancelled; and new claims 37-39 are added. Applicant respectfully requests reconsideration of the present claims in view of the foregoing amendment and the following remarks.

### I. Formal Matters:

#### Objection To IDS

Examiner Bissett objects to a previously submitted Information Disclosure Statement (IDS) mailed on September 04, 2003. Applicant have resubmitted or will resubmit a revised IDS to replace the September 04, 2003 IDS.

### II. Prior Art Rejections:

#### Rejection of Previously Presented Claims 27, 29 and 31 Under 35 U.S.C. §102(b) In View Of U.S. Patent No. 4,101,698 (Dunning)

Previously presented claims 27, 29 and 31 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,101,698 issued to Dunning et al. (hereinafter, "Dunning"). This rejection is respectfully traversed.

Applicants' claimed invention, embodied in independent claim 27, is drawn to an article comprising, *inter alia*, (i) a continuous, opaque layer of metal; (ii) a polyurethane substrate on a surface of the layer of metal; and (iii) at least one backing on a surface of the layer of metal opposite the polyurethane substrate, the backing comprising a pressure-sensitive adhesive foam tape.

The disclosure of Dunning discloses a laminate comprising: an adhesive layer, a reflective metal layer, an elastomeric film, a release coat and a carrier. See, for example, film 10 shown in FIG. 1, wherein film 10 comprises adhesive layer 20, reflective metal layer 18, elastomeric film 16, release coat 14 and carrier 12.

In order for the disclosure of Dunning to anticipate Applicant's claimed invention

as embodied in independent claim 27, the disclosure of Dunning must disclose each and every claim feature recited in independent claim 27. The disclosure of Dunning fails to teach or suggest at least the following claim features: an article comprising a polyurethane substrate on a surface of a layer of metal, wherein the article further comprises a pressure-sensitive adhesive foam tape. Accordingly, the disclosure of Dunning cannot anticipate Applicant's claimed invention as embodied in independent claim 27. Since claim 31 depends from independent claim 27 (previously presented claim 29 has been cancelled), and recites additional claim features, the disclosure of Dunning cannot anticipate Applicant's claimed invention as embodied in dependent claim 31.

For at least the reasons given above, the disclosure of Dunning fails to anticipate Applicant's claimed invention as embodied in claims 27 and 31. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Rejection of Previously Presented Claims 17-18, 21, 23-27 and 29-36 Under 35 U.S.C. §102(b) In View Of PCT Publication No. WO91/10562 (Ochi)

Previously presented claims 17-18, 21, 23-27 and 29-36 are rejected under 35 U.S.C. §102(b) as being anticipated by International Patent Publication No. WO91/10562 to Ochi et al. (hereinafter, "Ochi"). This rejection is respectfully traversed.

Applicants' claimed invention, embodied in independent claim 17, is drawn to an article comprising, *inter alia*, (i) a continuous, opaque layer of metal; (ii) a polyurethane substrate on an outer surface of the layer of metal; and (iii) at least one component on an outer surface of the polyurethane substrate opposite the layer of metal, wherein the at least one component comprises a printed message, a decorative pattern, a color layer, a polyurethane clear coat protective layer, or a combination thereof, and wherein at least part of the layer of metal is visible through the polyurethane substrate and the at least one component.

A description of Applicants' claimed invention as embodied in independent claim 27 may be relied upon above.

Applicants' claimed invention, embodied in independent claim 35, is drawn to an article comprising, *inter alia*, (i) a continuous, opaque layer of metal; (ii) a polyurethane substrate on an outer surface of the layer of metal; (iii) at least one component on an outer

surface of the polyurethane substrate opposite the layer of metal, wherein the at least one component comprises a printed message, a decorative pattern, a color layer, a polyurethane clear coat protective layer, or a combination thereof, and wherein at least part of the layer of metal is visible through the polyurethane substrate and the at least one component; and (iv) at least one backing on a surface of the layer of metal opposite the polyurethane substrate, the backing comprising an attachment system, a reinforcement material, or a combination thereof.

The disclosure of Ochi discloses a laminated resin film having a metallic appearance. The disclosed laminated resin film comprises: an outer polyvinyl chloride resin film layer, a solvent-based polyurethane resin film layer, a metal layer, an optional acrylic-type resin layer, and an adhesive layer.

In order for the disclosure of Ochi to anticipate Applicant's claimed invention as embodied in independent claims 17, 27 and 35, the disclosure of Ochi must disclose each and every claim feature recited in independent claims 17, 27 and 35. The disclosure of Ochi fails to teach or suggest at least the following claim features: an article comprising at least one component on an outer surface of a polyurethane substrate opposite a layer of metal, wherein the at least one component comprises a printed message, a decorative pattern, a color layer, a polyurethane clear coat protective layer, or a combination thereof (claims 17 and 35); and an article comprising a polyurethane substrate on a surface of a layer of metal, wherein the article further comprises a pressure-sensitive adhesive foam tape (claim 27). Accordingly, the disclosure of Ochi cannot anticipate Applicant's claimed invention as embodied in independent claims 17, 27 and 35. Since claims 18, 21, 23-24, 30-34 and 36 depend from independent claims 17, 27 and 35 (previously presented claims 25-26 and 29 have been cancelled), and recite additional claim features, the disclosure of Ochi cannot anticipate Applicant's claimed invention as embodied in dependent claims 18, 21, 23-24, 30-34 and 36.

For at least the reasons given above, the disclosure of Ochi fails to anticipate Applicant's claimed invention as embodied in claims 17-18, 21, 23-24, 27 and 30-36. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Rejection of Previously Presented Claims 19-20 and 22 Under 35 U.S.C. §103(a) In View  
Of Ochi In Combination With Dunning

Previously presented Claims 19-20 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Ochi in combination with the teaching of Dunning. This rejection is respectfully traversed.

A description of Applicants' claimed invention as embodied in independent claim 17 may be relied upon above. A description of the teachings of Ochi and Dunning may also be relied upon above.

Claims 19-20 and 22 depend from independent claim 17, and further recite the following claim features:

- (1) an article as recited in independent claim 17, wherein the metal is indium or an alloy thereof (claim 19);
- (2) an article as recited in independent claim 17, wherein the metal is tin or an alloy thereof (claim 20); and
- (3) an article as recited in independent claim 17, further comprising a primer layer on the layer of metal for improving adhesion to the layer of metal (claim 22).

As discussed above, the teaching of Ochi fails to disclose, teach or suggest an article as recited in independent claim 17, namely, an article comprising at least one component on an outer surface of a polyurethane substrate opposite a layer of metal, wherein the at least one component comprises a printed message, a decorative pattern, a color layer, a polyurethane clear coat protective layer, or a combination thereof. In addition, the teaching of Ochi fails to disclose, teach or suggest the above-described article wherein the metal comprises indium, tin, or an alloy of either indium or tin (claims 19-20). Further, the teaching of Ochi fails to disclose, teach or suggest the above-described article further comprising a primer layer on the layer of metal for improving adhesion to the layer of metal (claim 22).

Like the teaching of Ochi, the teaching of Dunning also fails to disclose, teach or suggest an article as recited in independent claim 17, namely, an article comprising at least one component on an outer surface of a polyurethane substrate opposite a layer of metal, wherein the at least one component comprises a printed message, a decorative pattern, a color layer, a

polyurethane clear coat protective layer, or a combination thereof. The teaching of Dunning fails to disclose, teach or suggest any layers on an outer surface of the disclosed elastomeric layer (e.g., layer 16 of film 10 shown in FIG. 1) other than a removable release coat (14) and a carrier (12) for the release coat.

It is respectfully submitted that even if the proposed combination of the teaching of Ochi with the teaching of Dunning is proper (and Applicant is of the opinion that there is no motivation or suggestion in the art for such a proposed combination), the resulting combined teaching of Ochi and Dunning still fails to disclose, teach or suggest Applicant's claimed invention as embodied in independent claim 17 and dependent claims 19-22 and 22. The resulting combined teaching of Ochi and Dunning still fails to disclose, teach or suggest an article comprising at least one component on an outer surface of a polyurethane substrate opposite a layer of metal, wherein the at least one component comprises a printed message, a decorative pattern, a color layer, a polyurethane clear coat protective layer, or a combination thereof.

For at least the reasons given above, the proposed combination of the teaching of Ochi and the teaching of Dunning fails to make obvious Applicant's claimed invention as embodied in claims 19-20 and 22. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Rejection of Previously Presented Claims 28 and 30 Under 35 U.S.C. §103(a) In View Of Dunning In Combination With Kunevicius

Previously presented Claims 28 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Dunning in combination with U.S. Patent No. 3,439,950 issued to Kunevicius (hereinafter, "Kunevicius"). This rejection is respectfully traversed.

A description of Applicants' claimed invention as embodied in independent claim 27 may be relied upon above. A description of the teaching of Dunning may also be relied upon above.

As discussed above, the teaching of Dunning fails to disclose, teach or suggest an article as recited in independent claim 27, namely, an article comprising a polyurethane substrate

on a surface of a layer of metal, wherein the article further comprises a pressure-sensitive adhesive foam tape.

The teaching of Kunevicius is directed to a resilient bumper molding or strip that can be adhesively attached to a vehicle. The disclosed molding comprises a body 10, a cellular cushion 14 position on a rear surface of body 10, and a pressure sensitive adhesive layer 15 on a rear surface of cellular cushion 14. It should be noted that the cushion layer 14 is not a pressure-sensitive adhesive foam tape as recited in independent claim 27. Further, the pressure sensitive adhesive layer 15 is not a pressure-sensitive adhesive foam tape as recited in independent claim 27. In addition, the disclosed molding does not comprise a metal layer as recited in independent claim 27.

It is respectfully submitted that even if the proposed combination of the teaching of Dunning with the teaching of Kunevicius is proper (and Applicant is of the opinion that there is no motivation or suggestion in the art for such a proposed combination), the resulting combined teaching of Dunning and Kunevicius still fails to disclose, teach or suggest Applicant's claimed invention as embodied in independent claim 27 and dependent claims 28 and 30. The resulting combined teaching of Dunning and Kunevicius still fails to disclose, teach or suggest an article comprising a polyurethane substrate on a surface of a layer of metal, wherein the article further comprises a pressure-sensitive adhesive foam tape.

For at least the reasons given above, the proposed combination of the teaching of Dunning and the teaching of Kunevicius fails to make obvious Applicant's claimed invention as embodied in claims 28 and 30. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Rejection of Previously Presented Claims 28 and 30 Under 35 U.S.C. §103(a) In View Of Ochi In Combination With Kunevicius

Previously presented Claims 28 and 30 are also rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Ochi in combination with Kunevicius. This rejection is respectfully traversed.

A description of Applicants' claimed invention as embodied in independent claim 27 may be relied upon above. A description of the teachings of Ochi and Kunevicius may also be

relied upon above.

As discussed above, the teaching of Ochi fails to disclose, teach or suggest an article as recited in independent claim 27, namely, an article comprising a polyurethane substrate on a surface of a layer of metal, wherein the article further comprises a pressure-sensitive adhesive foam tape.

It is respectfully submitted that even if the proposed combination of the teaching of Ochi with the teaching of Kunevicius is proper (and Applicant is of the opinion that there is no motivation or suggestion in the art for such a proposed combination), the resulting combined teaching of Ochi and Kunevicius still fails to disclose, teach or suggest Applicant's claimed invention as embodied in independent claim 27 and dependent claims 28 and 30. The resulting combined teaching of Ochi and Kunevicius still fails to disclose, teach or suggest an article comprising a polyurethane substrate on a surface of a layer of metal, wherein the article further comprises a pressure-sensitive adhesive foam tape.

For at least the reasons given above, the proposed combination of the teaching of Ochi and the teaching of Kunevicius fails to make obvious Applicant's claimed invention as embodied in claims 28 and 30. Accordingly, Applicant respectfully requests withdrawal of this rejection.

### III. Double Patenting Issues:

#### Objection To Previously Presented Claim 25:

In the February 24, 2005 office action, Examiner Bissett states that if previously presented claim 25 is allowable, claims 32 and 35 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. As shown in the claim amendments above, previously presented claim 25 has been cancelled.

#### Obviousness-Type Double Patenting Rejection of Previously Presented Claims 17-23 In View Of Claims 1-11 of U.S. Patent No. 6,071,621

Previously presented claims 17-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,071,621. This rejection is respectfully traversed.

Applicant respectfully submits that pending claims 17-23 are patentably distinct from claims 1-11 of U.S. Patent No. 6,071,621. However, Applicant is willing to discuss the possibility of submitting a terminal disclaimer, if necessary, to expedite prosecution of pending claims 17-24, 27-28 and 30-39.

Obviousness-Type Double Patenting Rejection of Previously Presented Claims 24-27, 29 and 31-36 In View Of Claims 1-11 of U.S. Patent No. 6,071,621 and Ochi

Previously presented claims 24-27, 29 and 31-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,071,621 in view of the teaching of Ochi. This rejection is respectfully traversed.

Applicant respectfully submits that pending claims 24, 27 and 31-36 are patentably distinct from claims 1-11 of U.S. Patent No. 6,071,621 (previously presented claims 25-26 and 29 have been cancelled) in view of the teaching of Ochi. Claims 1-11 of U.S. Patent No. 6,071,621 do not recite (i) an article comprising a colorant in a polyurethane substrate layer (claim 24), (ii) an article comprising a pressure-sensitive adhesive foam tape (claims 27 and 31-34), or (iii) an article comprising at least one backing on a surface of a layer of metal opposite a polyurethane substrate, the backing comprising an attachment system, a reinforcement material, or a combination thereof (claims 35-36). As discussed above, the teaching of Ochi fails to disclose, teach or suggest various claim features recited in Applicant's claims including an article comprising a pressure-sensitive adhesive foam tape (claims 27 and 31-34).

For at least the reasons given above, it is respectfully submitted that pending claims 24, 27 and 31-36 are patentably distinct from claims 1-11 of U.S. Patent No. 6,071,621 (previously presented claims 25-26 and 29 have been cancelled) in view of the teaching of Ochi. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Obviousness-Type Double Patenting Rejection of Previously Presented Claims 28 and 30 In View Of Claims 1-11 of U.S. Patent No. 6,071,621 and Ochi and Kunevicius

Previously presented claims 28 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,071,621 in view of the teachings of Ochi and Kunevicius. This rejection is



respectfully traversed.

Applicant respectfully submits that pending claims 28 and 30 are patentably distinct from claims 1-11 of U.S. Patent No. 6,071,621 in view of the teachings of Ochi and Kunevicius. Claims 1-11 of U.S. Patent No. 6,071,621 do not recite an article comprising a pressure-sensitive adhesive foam tape (claims 27, 28 and 30). As discussed above, each of the teachings of Ochi and Kunevicius fails to disclose, teach or suggest various claim features recited in Applicant's claims including an article comprising a pressure-sensitive adhesive foam tape (claims 27, 28 and 30).

For at least the reasons given above, it is respectfully submitted that pending claims 28 and 30 are patentably distinct from claims 1-11 of U.S. Patent No. 6,071,621 in view of the teachings of Ochi and Kunevicius. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Obviousness-Type Double Patenting Rejection of Previously Presented Claims 17-36 In View Of Claims 1-14 of U.S. Patent No. 6,641,921

Previously presented claims 17-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,641,921. This rejection is respectfully traversed.

Applicant respectfully submits that pending claims 17-36 are patentably distinct from claims 1-14 of U.S. Patent No. 6,641,921. However, Applicant is willing to discuss the possibility of submitting a terminal disclaimer, if necessary, to expedite prosecution of pending claims 17-24, 27-28 and 30-39.

IV. New Claims 37-39:

New claims 37-39 are directed to further embodiments of Applicant's claimed invention. New claims 37-39 depend from independent claims 17, 27 and 35 discussed above.

Support for new claims 37-39 may be found in at least the following locations of the original specification: page 3, lines 16-21, and page 7, lines 1-4 (claims 37-39).

Applicants respectfully submit that new claims 37-39 are patentable over the art of record for at least the reasons given above in regard to claims 17-24, 27-28 and 30-36.

V. Conclusion:

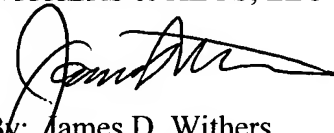
For at least the reasons given above, Applicant submits that claims 17-24, 27-28 and 30-39 define patentable subject matter. Accordingly, Applicant respectfully requests allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should the Examiner believe that anything further is necessary to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicant's representative at the telephone number listed below.

Respectfully submitted,

WITHERS & KEYS, LLC

  
By: James D. Withers  
Reg. No. 40,376

WITHERS & KEYS, LLC  
18 Atlanta Street  
McDonough, GA 30253  
678-565-4748

Attorney Docket No. 10002.0103US01  
3M Docket No.: 48748US019